

Docket No.: 500200850-2 US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	: : EXPEDITED PROCEDURE
	: : Response under 37 CFR 1.116
Inventors: Paul NEUMAN et al.	: Confirmation No. 3057
	:
U.S. Patent Application No. 10/643,079	: Group Art Unit: 2135
	:
Filed: August 19, 2003	: Examiner: Beemnet W Dada
	:

For: DATA PROCESSING SYSTEM AND METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria VA 22313-1450

Sir:

This paper is submitted in reply to the Final Office Action mailed *August 21, 2007*.

Applicants respectfully request review of the final rejections of claims **1-24** as manifested in the Final Office Action. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal in compliance with *37 CFR 41.31* and the fee set forth in *37 CFR 41.20(b)(1)*.

The review is requested for the reasons stated on the attached sheets.

REASONS

The following clear errors are found in the Examiner's rejections.

1. With respect to independent **claims 1, 15 and 16**, Applicants respectfully disagree with the Examiner's rejection, because the applied reference fails to teach or suggest the claimed "non-volatile storage medium including configuration data that describes a configuration of the non-volatile storage medium." As argued in Applicants' June 5, 2007 Amendment, at page 12, which is incorporated by reference herein, the *Chaiken* BIOS (considered by the Examiner to read on the claimed configuration data) is not disclosed or suggested to describe a configuration of ROM 102 (considered by the Examiner to read on the claimed non-volatile storage medium).

The Examiner responded to the above argument in the Final Office Action in paragraph 3. Basically, the Examiner (i) alleged that the *Chaiken* BIOS includes verification data,¹ and (ii) argued that the verification data is equivalent to configuration data for configuring the flash ROM 102.² The Examiner's allegation and argument are flawed for the following reasons.

With respect to (i), the *Chaiken* BIOS is not disclosed to include the verification data. It is the BIOS image that includes verification data.³ As defined by *Chaiken*, the BIOS image is "the new BIOS data that a user wants to have flashed into the existing Flash ROM BIOS part."⁴ A person of ordinary skill in the art would understand that the BIOS image itself does not reside in the ROM. Rather, the BIOS image is stored in a different storage medium, such as a floppy disk, a hard disk, a CD-ROM, a system memory etc.,⁵ and will become the new BIOS after a successful flash. The new BIOS, however, is not disclosed or suggested by *Chaiken* to still include the verification data which is required only before, not after, the BIOS flashing. Accordingly,

¹ See, Final Office Action at paragraph 3, line 3.

² See, Final Office Action at paragraph 3, lines 6-9.

³ See, for example, *Chaiken* at column 4, paragraph 0018.

⁴ See, for example, *Chaiken* at column 4, lines 19-20.

Applicants respectfully submit that, contrary to the Examiner's allegation, *Chaiken* does not teach or suggest any verification data that is appended to the BIOS in the ROM 102.

With respect to (ii), the *Chaiken* verification data is not equivalent to configuration data for configuring the flash ROM 102. As disclosed by *Chaiken*, the verification data is only "means for verifying that the BIOS image is compatible with the computer."⁶ Thus, the verification data is related only a "configuration" of the BIOS image, rather than to a configuration of the ROM 102. This is especially true in the specific embodiment of *Chaiken* where the verification data is disclosed to be a checksum or signature.⁷ A person of ordinary skill in the art would understand that a checksum or signature is generally a hashed value and is not configuration data. Accordingly, Applicants respectfully submit that, contrary to the Examiner's allegation, the *Chaiken* verification data is unrelated to the ROM 102 and is not equivalent to configuration data of the ROM 102.

Thus, *Chaiken* fails to teach or suggest any configuration data which both resides in the non-volatile storage medium⁸ and describes a configuration of the non-volatile storage medium.⁹ The anticipatory rejection of the independent claims is therefore inappropriate and should be withdrawn.

The dependent claims are considered patentable at least for the reasons advanced with respect to the respective independent claims. The dependent claims are also patentable on their own merits since these claims recite other features neither disclosed, taught nor suggested by the applied art, as will be detailed herein below.

⁵ See, for example, *Chaiken* at 306 and 314 in FIG. 3.

⁶ See, for example, *Chaiken* at column 4, lines 21-22.

⁷ See, for example, *Chaiken* at 212 in FIG. 2 and paragraphs 0021, 0022, 0028-0029.

⁸ The *Chaiken* verification data is part of the BIOS image which does not reside in the ROM 102.

⁹ The *Chaiken* verification data is related only to the BIOS image, and does not describe a configuration of the ROM 102.

2. With respect to **claims 4 and 6**, Applicants respectfully traverse the Examiner's rejection for the reason(s) presented in the Amendment filed June 5, 2007, at page 13 the third full paragraph, which is incorporated by reference herein. The Examiner has not responded to Applicants' argument, failing to follow proper USPTO practice and procedure.¹⁰

3. With respect to **claim 8**, Applicants respectfully traverse the Examiner's rejection for the reason(s) presented in the Amendment filed June 5, 2007, at the paragraph bridging pages 13-14, which is incorporated by reference herein. The Examiner has not responded to Applicants' argument, failing to follow proper USPTO practice and procedure.¹¹

4. With respect to **claim 13**, Applicants respectfully traverse the Examiner's rejection for the reason(s) presented in the Amendment filed June 5, 2007, at page 14 the first full paragraph, which is incorporated by reference herein. The Examiner has not responded to Applicants' argument, failing to follow proper USPTO practice and procedure.¹²

5. With respect to **claim 23**, Applicants respectfully traverse the Examiner's rejection for the reason(s) presented in the Amendment filed June 5, 2007, at page 14 the second full paragraph, which is incorporated by reference herein. The Examiner's reliance on paragraphs 0030-0033 of *Chaiken* for the claimed "hanging" feature is noted. Applicants have carefully reviewed the cited paragraphs and still failed to find any teaching of the claimed "hanging" feature. The closest teaching of *Chaiken* appears to be paragraph 0031 where it is disclosed that "the flashing process is stopped and an error message is displayed." This teaching is, however, neither indicative nor suggestive of whether the *Chaiken* computer would be hung in response to such error message. The reference clearly fails to teach or suggest the claim feature.

¹⁰ MPEP, section 707.07(f). Answer All Material Traversed: Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

¹¹ *Id.*

¹² *Id.*

6. With respect to **claim 24**, Applicants respectfully traverse the Examiner's rejection for the reason(s) presented in the Amendment filed June 5, 2007, at page 14 the third full paragraph, which is incorporated by reference herein. The Examiner has not responded to Applicants' argument,¹³ failing to follow proper USPTO practice and procedure.

Withdrawal of the final rejections in view of the above is believed appropriate and therefore respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

Paul NEUMAN et al.



Randy A. Noranbrock
Registration No. 42,940

HEWLETT-PACKARD COMPANY

IP Administration

Legal Department, M/S 35

P.O. Box 272400

Fort Collins, CO 80528-9599

Facsimile: 281-926-7212

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¹³ See, Final Office Action at paragraph 6 where claim 24 is rejected together with claim 1.